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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/764,725	01/17/2001	Richard L. Maliszewski	42390P6532C	8454

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EXAMINER

KISS, ERIC B

ART UNIT PAPER NUMBER

2122

DATE MAILED: 10/06/2003

6

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/764,725

Applicant(s)

MALISZEWSKI, RICHARD L.

Examiner

Eric B. Kiss

Art Unit

2122

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 10 April 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 April 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. Claims 1-16 have been examined.

#### ***Response to Arguments***

2. Applicant's arguments submitted with the Preliminary Amendment of April 10, 2003, have been considered in light of the office action mailed December 4, 2000, for parent Application No. 09/217,498, filed December 21, 1998, and now abandoned. Applicant's arguments are considered moot in view of the new grounds of rejection presented below.

#### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1, 3-5, 7-9, and 11-16 are rejected under 35 U.S.C. 102(b) as being anticipated by International Publication No. WO 97/04394 to Drake.

As per claims 1, 5, and 9, *Drake* discloses generating a software test module to produce a test result by performing a test on instructions (see, for example, page 14, line 34, through page 15, line 5; and page 16, line 6, through page 17, line 23); in the instructions, replacing a first instruction comprising a target address with a second non-identical instruction having an instruction address in the instructions, the second instruction to transfer control to the test module (see, for example, page 16, lines 20-32); and storing the target address encrypted in a table, the test module to locate the target address in the table and to set an execution address to the target address if the test result indicates the instructions are to proceed (see, for example, page 15, lines 8-11; and page 17, line 21, through page 18, line 27).

As per claims 3, 7, and 11, *Drake* further discloses corresponding the target address with the instruction address in the encrypted table (see, for example, page 18, line 28, through page 19, line 6).

As per claims 4, 8, and 12, *Drake* further discloses profiling the instructions to identify the first instruction as an instruction to replace (see, for example, page 16, lines 20-25).

As per claim 13, *Drake* discloses transferring control to a software test module when a second instruction having an instruction address in the instructions is executed by a data processing device, the second instruction replacing a non-identical first instruction comprising a target address (see, for example, page 16, lines 20-32);

a test module comprising a table comprising a target address of the replaced first instruction (see, for example, page 16, lines 26-32); and test instructions to produce a test result by performing a test on the instructions, the test module to locate the target address in the table

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and to transfer control to the target address if the test result indicates the instructions are to proceed (see, for example, page 18, line 28, through page 19, line 6).

As per claim 14, Drake further discloses loading the test module (see, for example, page 15, lines 8-11).

As per claim 15, Drake further discloses the test module comprising instructions to set an exception handler to transfer control to the test instructions when the second instruction is executed by the data processing device (see, for example, page 19, lines 14-18).

As per claim 16, Drake further discloses the test module comprising instructions moved from the instructions, the instructions moved to make room in the instructions for the instructions to load the test module (see, for example, page 16, lines 26-32).

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 2, 6, and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over International Publication No. WO 97/04394 to Drake in view of U.S. Patent No. 5,966,541 to Agarwal.

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As per claim 2, 6, and 10, Drake discloses such features (see the disclosure applied above to claims 1, 5, and 9) but fails to expressly disclose compacting the instructions to eliminate a hole created by replacing the first instruction with the second instruction. However, Agarwal teaches that it is known to shift a set of instructions in conjunction with the act of inserting or removing an instruction (see, for example, column 7, lines 20-26; note that replacing an instruction is the equivalent of inserting a new instruction and deleting an old instruction). Therefore, it would have been obvious to one having ordinary skill in the computer art at the time the invention was made to modify the invention of Drake to include compacting instructions to eliminate a hole created by replacing an instruction. One would be motivated to do so to prevent invalid op codes, as an artifact of a replaced instruction, from remaining in a set of instructions.

### *Conclusion*

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The following documents are cited as considered relevant by the Examiner of parent Application No. 09/217,498:

US 5,134,701 (Mueller et al.)

US 5,313,616 (Cline et al.)

US 5,335,344 (Hastings)

US 5,386,471 (Bianco)

US 5,603,045 (Dockser)

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US 5,721,945 (Mills et al.)

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric B. Kiss whose telephone number is (703) 305-7737. The examiner can normally be reached on Tue. - Fri., 7:30 am - 5:00 pm. The examiner can also be reached on alternate Mondays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tuan Dam can be reached on (703) 305-4552.

**Any response to this action should be mailed to:**

Commissioner for Patents  
P.O.Box 1450  
Alexandria, VA 22313-1450

**Or faxed to:**

(703) 872-9306 (for formal communications intended for entry)

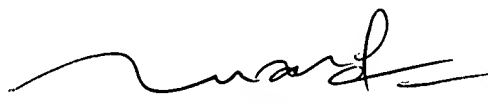
**Or:**

(703) 746-7240 (for informal or draft communications, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA, 22202, Fourth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

EBK  
October 1, 2003

  
**TUAN DAM**  
**SUPERVISORY PATENT EXAMINER**